

Remarks

This paper is submitted in response to the Office Action mailed December 26, 2007, to which the Applicant filed a Notice of Appeal under 37 CFR 1.302 on June 26, 2008. This paper is therefore believed to be timely filed along with a petition for extension of time for five (5) months under 37 CFR 1.17(a)(5) and further under 37 CFR 1.136(a)(1), and is accompanied by a Request for Continued Examination under 37 CFR 1.114. The Office is hereby authorized to deduct the requisite fees for the petition for extension of time and for the RCE from the Applicants USPTO Deposit Account 13-4125 in the name of Monsanto Company and to refund any amounts overpaid.

With this submission, claims 11-20 and new claims 25-30 are pending in this application, and this submission is believed to be fully responsive to the official Action mailed June 26, 2008.

Claims 11-20 and 25-27 are pending in this case. With this response, claims 15-16, and 19-20 have been amended, and new claims 25-30 have been added. The amendments and new claims are believed to be fully supported by the specification and original claims as filed and do not add new matter. Reference in claim 28 to “one or more antifungal proteins” can be found at least in the specification as filed in paragraph [0064]; and reference to a plant (and necessarily a plant cell) comprising the antifungal protein of SEQ ID NO:4, more than one antifungal protein, and a B.t. insecticidal protein can be found in the specification as filed at least at paragraphs [0054]-[0055]. It is respectfully requested that the Examiner enter the amendments and reconsider the claims in view of the amendments and the remarks provided below, and find that all of the claims are now in condition for allowance.

The Examiner found that claims 11-14 were allowed with the mailing of the final rejection in the most recent Office Action in this case. Claim 15 has been amended to recite “or” as this claim is not intended to recite a Markush grouping. Claim 16 has been amended to overcome the Examiner’s rejection. Claim 19 has been amended to indicate dependency from claim 16 instead of claims 17, and claim 20 has been amended to remove the recitation of the term “host”. New claims 25-30 recite various embodiments of original claims 19 and 22 and/or are furthermore supported by the specification.

The Examiner rejected claims 16-20 under 35 USC 112, first paragraph as lacking enablement for any plant pathogenic fungi other than *Fusarium* or *Verticillium* species. The Applicant again traverses this rejection.

It is believed that the amendment to claim 16 obviates the Examiner’s rejection of this and the claims dependent thereon. Paragraph [0068] of the specification as filed provides support for the utility of the recited protein as set forth at SEQ ID NO:4 in controlling fungi in a wide variety of plants exemplified by a plethora of plant pathogenic fungal species as set forth therein. The examples which demonstrate the antifungal protein properties of the protein as set forth at SEQ ID NO:4 directed against two plant pathogenic fungal species from the plethora of plant pathogenic fungal species set forth at shown in paragraph [0068] of the specification is believed to reasonably provide enablement for the

limited number of plant pathogenic fungal species recited in the claims. The Applicant is not required to fully demonstrate activity in each and every species that could possibly be tested, but a reasonable number of such species is sufficient for demonstrating that the applicant was in full possession of the metes and bounds of the subject matter claimed. The Examiner has provided no evidence as to why the skilled artisan would not expect to be able to extrapolate the range of examples across the entire scope of the claims and therefore has not met his burden for giving reasons for the asserted lack of enablement. The specification provides working examples in which the protein as set forth in SEQ ID NO:4 exhibits antifungal activity against two species of plant pathogenic fungi across two different genera, and the claims are at most expansive across three genera of plant pathogenic fungi and are inclusive of two of these genera that are exemplified by the teachings of the examples. The Examiner merely speculates that it won't work because not all of the species have been evaluated, and the Examiner has not shown any evidence in any publication or other document that the skilled artisan would not reasonably expect that the protein as set forth at SEQ ID NO 4 would function as described. No undue experimentation would be necessary for the skilled artisan to evaluate the scope of the claims across the balance of the general within the scope of the claims. Therefore, in the absence of any clear showing of a lack of enablement of the scope of the claims by the Examiner, and in view of the teachings of the specification as filed, it is believed that the claims are fully enabled under 112 first paragraph.

Therefore, in view of these remarks and the amendments to the claims, it is believed that the 112 first paragraph rejection is obviated and so it is respectfully requested that the Examiner remove this grounds of rejection.

If there are any questions or minor amendments that can facilitate the allowance of the claims in this matter, it is respectfully requested that the Examiner contact the undersigned attorney.

Respectfully submitted,

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